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In re Application of
MIROSHNICHENKO et al.
Application No.: 09/242,219
PCT No.: PCT/UA96/00016
Int. Filing Date: 13 November 1996
Priority Date: 10 September 1996
Attorney's Docket No.: 990056
For: HIGH DEFINITION TELEVISION SYSTEM

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: DECISION ON
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: PETITION
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: UNDER 37 CFR 1.182
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Applicants' "PETITION TO ACCEPT DECLARATION" filed 07 February 2000, has been treated as a petition under 37 CFR 1.182. As authorized in the petition, the required petition fee has been charged to Deposit Account No. 02-4553.

BACKGROUND

On 13 November 1996, applicant filed the above-identified international application, which claims a priority date of 10 September 1996 and designates the U.S. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 19 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 02 April 1998, prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 10 March 1999.

On 09 February 1999, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee, the surcharge under 37 CFR 1.492(e) for furnishing the oath or declaration later than 30 months from the earliest claimed priority, and a translation of the international application.

On 24 November 1999, the United States Designated/Elected Office (DO/EO) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b).

The notification set a one-month period for reply.

On 06 December 1999, applicants submitted a declaration of inventors listing five joint inventors with signatures of four of the five inventors.

On 04 January 2000, the USPTO mailed a NOTIFICATION OF A DEFECTIVE RESPONSE (Form PCT/DO/EO/916) with an attached NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) indicating that the response filed 06 December 1999 did not complete all of the requirements set forth in the NOTIFICATION OF MISSING REQUIREMENTS. Specifically, it was noted that the inventor Valeri Lydvikovich Koutsevich did not sign the declaration. Form 916 also stated that "[i]f there is a change, please file a petition indicating such change." The time limit for response was set at one month from the date of mailing of the NOTIFICATION OF A DEFECTIVE RESPONSE or within the time remaining in the response set forth in the NOTIFICATION OF MISSING REQUIREMENTS, whichever was longer. It was also noted that no extension of this time limit would be granted under 37 CFR 1.136 but that the period for response in the NOTIFICATION OF MISSING REQUIREMENTS may be extended up to a maximum of six months.

On 07 February 2000, applicants submitted the present "PETITION TO ACCEPT DECLARATION", which has been treated as a petition under 37 CFR 1.182.

On 03 April 2000, Michael G. Panian submitted a "REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT" requesting that he be withdrawn as attorney of record.

DISCUSSION

Petition Under 37 CFR 1.182

The petition states that Valeri Lydvikovich Koutsevich was the agent for the filing of the international application and was listed on the declaration as an inventor inadvertently. However, Valeri Lydvikovich Koutsevich is identified as an inventor, not as an agent. Thus, the declaration states that there are five inventors, not four. Additionally, the four inventors who signed the declaration signed a declaration stating that there were five inventors, not four. Because the declaration listed five inventors but was only signed by four of them, it is not in compliance with 37 CFR 1.497(a)-(b).

The proper reply to the NOTIFICATION OF MISSING REQUIREMENTS and the NOTIFICATION OF A DEFECTIVE RESPONSE would have been a new declaration listing only the four inventors and signed by each of them. (Note also that if the declaration contains a typographical or transliteration error in the spelling of an inventor's name (e.g., the first named inventor in the above-identified application is listed as Sergei in the published international

application but as Sergey in the declaration filed 06 December 1999), the Office should be notified of the error.) Because the NOTIFICATION OF A DEFECTIVE RESPONSE suggested that a proper response could be a petition, applicants' petition appears to be a *bona fide* attempt to reply.

Request For Withdrawal

The criteria for effecting a proper withdrawal of attorney are spelled out in Section 402.06 of the Manual of Patent Examining Procedure (MPEP) which reads, in part, as follows:

In the event that a notice of withdrawal is filed by an attorney or agent of record . . . appropriate procedure will be followed pertaining to the withdrawal. The withdrawal is effective when approved rather than when received.

To expedite the handling of requests for permission to withdraw as attorney, under 37 CFR 1.36, the request should be submitted in triplicate (original and two copies) and indicate thereon the present mailing addresses of the attorney who is withdrawing and of the applicant. The examining group number should also appear on all such requests. Because the Office does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of another.

The Commissioner of Patents and Trademarks usually requires that there be at least thirty days between *approval* of the withdrawal and the latter of the expiration date of a time response period or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). This is so that the applicant will have sufficient time to obtain other representation or take other action.

The declaration submitted 06 December 1999, in the middle of page 2, contains the language "[a]dditional registered practitioner(s) named on supplemental Registered Practitioner Information sheet PTO/SB/02C attached hereto". A Form PTO/SB/02C is attached to the declaration and lists five additional registered practitioners. The request for withdrawal is not signed by each of these attorneys. Nor does the request for withdrawal contain a clear indication that the attorney signing is signing on behalf of these others. Thus, the request is not clear. Moreover, it is noted that even if the request is granted, five attorneys in petitioner's law firm would still be of record in the application. Thus, correspondence would still be directed to petitioner's law firm even though, as stated in the request for withdrawal, the firm has not been paid. Consequently, it is inappropriate to grant the request for withdrawal at this time.

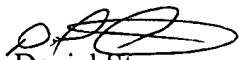
CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.182 to accept the declaration filed 06 December 1999 is **DISMISSED**.

For the reasons set forth above, the request to withdraw as attorney of record is **NOT APPROVED**.

Applicants are required to file 1) an oath or declaration in compliance with 37 CFR 1.497(a)-(b), and 2) an explanation as to why the inventors signed a declaration listing non-inventor Valeri Lydvikovich Koutsevich where this person was clearly identified as an agent in the published international application, within a time limit of ONE (1) MONTH from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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